

O'Brien
10/039,440REMARKS

In response to the Office Action, dependent Claims 3 and 13 have been canceled, without prejudice. Independent Claims 1 and 11 have been amended to require detecting and removing black bands from the input video stream, which are not taught by Bresalier et al (5,513,181).

For anticipation of a claim under 35 U.S.C. § 102, a single prior art reference must contain each and every limitation of the claim, either expressly or under the doctrine of inherency. *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1570 (Fed. Circ), cert. denied, 488 U.S. 892 (1988). To “contain” the limitation the reference must explicitly describe the limitation, or describe an operation inherently requiring the limitation, completely enough to place limitation “in the possession of the public.” *In re Epstein*, 32 F.3d 1559, 31 USPQd 1817 (Fed. Cir. 1994).

Bresalier et al (5,513,181), which does not describe detection and removal of black bands as an integral part of intra-transcoding, does not anticipate amended independent Claim 1 or 11, or any of the remaining un-canceled claims, all of which depend from either Claim 1 or 11.

For an obviousness type rejection to be proper, the prior art relied on by the Examiner must contain a suggestion or teaching of what is being claimed. To support a conclusion of *prima facie* obviousness, either the references must expressly or impliedly suggest the claimed combination or the examiner must present a convincing line of reasoning as to why the person of ordinary skill in the art would have found the claimed invention obvious in light of the teachings of the references. *ACS Hosp. Sys., Inc. v. Monteviore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the

O'Brien
10/039,440

combination. *ACS Hosp. Sys.*, 732 F.2d at 1577, 221 USPQ at 933. And teachings of references can be combined *only* if there is some suggestion or incentive to do so.

Bresalier et al (5,513,181) in combination with the Examiner's official notices, do not suggest or teach detection and removal of black bands, as required by Claims 1 and 11, and the remaining un-canceled claims, all of which depend from either Claim 1 or 11. Consequently, Bresalier et al (5,513,181) in combination with the Examiner's official notices does not anticipate the amended claims.

A power of attorney and change of correspondence address are provided with this response. Kindly amend the file to reflect Mark J. Young (Reg. No. 39,436) as the attorney of record, and the new correspondence address as:

Mark Young P.A.
9951 Atlantic Blvd., Suite 227
Jacksonville, Florida 32225
Tel. 904-721-0600
Cell. 904-571-8141
Fax. 904-721-0686

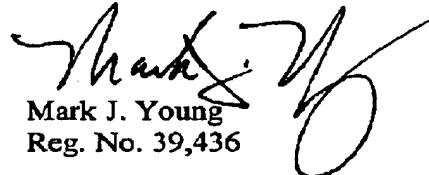
O'Brien
10/039,440

CONCLUSION

Applicant believes that a full and complete response has been made to the outstanding Office Action. Applicant further believes that claims 1,2, 4-12 and 14-20 are in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment is respectfully requested.

Respectfully submitted,


Mark J. Young
Reg. No. 39,436

January 16, 2004

Mark Young P.A.
9951 Atlantic Blvd., Suite 227
Jacksonville, Florida 32225
Tel. 904-721-0600
Cell. 904-571-8141
Fax. 904-721-0686